

Application Serial No.: 09/877,926
Attorney Docket No. 019213-0311368 (23424-016)
In Response to Office Action mailed July 6, 2005

REMARKS

In response to the Non-Final Office Action mailed July 6, 2005 (hereinafter "Office Action"), claims 1, 5-8, 11-12, 14-15, 19-22, 25-28, 32-35, 38-39, 41-42, 46-49, and 52-54 have been amended. No claims have been cancelled or newly added. Therefore, claims 1-59 remain pending. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

OATH/DECLARATION

The Examiner alleges that the oath or declaration is defective for lack of a residence address. *See* Office Action, pg. 3. In response, a Supplemental Oath is being submitted herewith, which provides Applicant's residence address.

SPECIFICATION

In the Office Action, at pgs. 2-3, the Examiner objects to the Abstract as allegedly including language that may be implied. Although Applicant disagrees with the objection of the Examiner, the Abstract has been amended solely in an effort to expedite prosecution. Accordingly, withdrawal of this objection is earnestly sought.

NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1-59 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-37 of co-pending Application No. 09/732,008. *See* Office Action, pg. 9. While not acknowledging the

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merits of the position taken by the Examiner, Applicant will consider filing a Terminal Disclaimer, upon the indication of allowable subject matter, solely to expedite prosecution.

REJECTIONS UNDER 35 U.S.C. §101

Claims 1-27 and 55-59 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner alleges that the claimed subject matter “*consists solely of the manipulation of an abstract idea and is not concrete or tangible.*” The Examiner further alleges that the invention is “*...devoid of any limitation to a practical application in the technological arts.*” *See* Office Action, pg. 5. Applicant traverses this rejection.

The claimed subject matter of claims 1-27 and 55-59 is neither abstract nor intangible. The aforementioned claims are directed to computer implemented methods and include recitations to, among other things, an electronic (or on-line) forum. As such, the Examiner’s rejection is without merit. Moreover, the Examiner’s general allegations (at pg. 5) that certain claim terms “*may be an abstraction*” or are considered “*trivial per se*” are provided without any basis or supporting legal authority.

Additionally, the Examiner’s “technological arts” rejection is improper for *at least* the reason that the Examiner is improperly reading limitations into 35 U.S.C. §101 on the subject matter that may be patented. The Board of Patent Appeals and Interferences has held that “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Ex Parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). As such, the Examiner’s focus on whether the claims apply, involve, use or advance the technological arts is not relevant.

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Accordingly, for at least each of the foregoing reasons, the rejection of claims 1-27 and 55-59 under 35 U.S.C. §101 is legally improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-59 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. See Office Action, pgs. 3-4. Applicant traverses this rejection.

The term “collaborate” is a well understood term and is clearly used in the Specification. Among other things it is clear, for example, that a team of financial advisors can collaborate with a common client to provide financial advice. This provides, for example, a common tool to enable these participants to interact and/or share information. *See* Specification, *e.g.*, pages 4 and 15.

The term “forum” is also clearly used, for example, in the context of a common electronic forum.

The words “enabling” and “to interact” are also clear. The basis for rejection is not clear. These are well understood words and are used clearly in the Specification. Should the Examiner maintain these rejections, further specificity is requested.

The terms “events” and “actions” are also clear.

The terms “clients” and “participants” are also clear. As clearly indicated at page 5 of the Specification, for example, participants can *include* financial advisor participants and client participants (among other participants). For example, a client may be a person to whom a financial advisor provides financial advice.

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The term "library of resources" is clear from the Specification. *See* Specification, *e.g.*, pages 68+.

The foregoing recitations (and citations to the Specification) are exemplary and should not be viewed as limiting.

With regard to claims 4 and 18, Applicant notes that these claims are clear as well. In claims 4 and 18, the forum is recited to include "modification information" associated with a client. This information can include information regarding actions that are associated with one or more participants (*e.g.*, actions taken on behalf of a client). In part, this enables a history of actions to be provided on a per client basis. *See* Specification, *e.g.*, page 44.

The blanket rejection of all dependent claims, at pg. 4 of the Office Action, as "*encompassing a rejected independent claim*" is improper and traversed. Each dependent claim recites subject matter not claimed in an independent claim. It is not clear how a narrower claim encompasses a broader claim. In any event, each claim must be considered in making a rejection. Should the Examiner maintain the rejection of the dependent claims, Applicant requests that the Examiner consider and address each claim as required.

The rejection of claims 28-54 is improper and unclear. Each of these claims recites a system, which is clearly a statutory class of invention.

For at least each of the foregoing reasons, the rejections under 35 U.S.C. §112, second paragraph are improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. §103

Claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich *et al.*

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(“Zuchnovich”). *See* Office Action, pg. 6.

Claims 6, 20-21, 33, and 47-48 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 6,430,542 to Moran. *See* Office Action, pg. 7.

Claims 55 and 56 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 5,787,175 to Carter. *See* Office Action, pg. 8.

Claim 59 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 6,243,722 to Day *et al.* (“Day”). *See* Office Action, pg. 8.

Applicant traverses these rejections for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness, and maintains the arguments set forth in the previous responses.

Zucknovich fails to disclose, teach, or suggest one or more features of independent claims 1, 15, 28, 42, and 57, and is non-analogous. Zucknovich relates generally to distributing electronic information (*e.g.*, research reports) from a research provider. There is no collaboration among participants of a team and no common forum (much less accessibility of client data through a common forum), nor a scope of authorized access for each participant, among other things. For at least these reasons, the rejection of independent claims 1, 15, 28, 42, and 57 is improper and should be withdrawn. Dependent claims 2-14, 16-27, 29-41, 43-56, and 58-59 are allowable at least because they depend from allowable independent claims, as well as for the further limitations they contain.

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Despite the contention of the Examiner (at pg. 10), a reference is not analogous simply because it is capable of performing the function of the instant application. That is not the relevant test for determining whether or not a reference is analogous. Even if that were the test, it is not clear that such an assertion would be true here. Regardless, since Zucknovich does not qualify as analogous art, each of the rejections based thereon must fail. The Examiner has also failed to establish that that any of the other references relied upon qualify as analogous art.

Additionally, the Examiner's assertion (at pg. 10) that Zucknovich in view of Moran is admitted art is traversed. No such admission was made. The response filed on April 25, 2005 focused on the deficiencies of the base reference, Zucknovich, and recited that "*[n]one of the prior art relied on shows the features claimed...*" See 4/25/05 Amendment at pg. 14. **Emphasis added.** Applicant notes that there are numerous bases upon which to attack the alleged combinations of the secondary references with Zucknovich. While Applicant expressly reserves the right to present such arguments at a future time, it is not necessary to do so at this time as the secondary references fail to cure the deficiencies of the primary reference (Zucknovich) articulated above, assuming arguendo that the references could even be properly combined.

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CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: November 7, 2005

Respectfully submitted,

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